

## REMARKS

Reconsideration and timely allowance of the pending claims, in view of the following remarks, are respectfully requested.

In the pending Office Action, the Examiner rejected claims 1-3, 5, 7, 15-17, and 19, under 35 U.S.C. §102(e), as being anticipated by Hol '296 (U.S. Patent No. 6,717,296). The Examiner also objected to the Drawings, under 37 CFR §1.83(a), as lacking the feature of “a load”, as recited in claims 1 and 15.

In addition, the Examiner indicated that remaining claims 4, 6, 8, and 20 would be allowable if rewritten in independent form.

Prior to this Amendment, claims 1-7 and 15-20 were pending, of which claims 1 and 15 were independent. By this Amendment, Applicants have amended independent claims 1 and 15 to provide a clearer presentation of the claimed subject matter. As such, claim 1-7 and 15-20 are once again presented for examination, of which claims 1 and 20, remain as the independent claims.

Applicants have revised the Specification and the Drawings, as evidenced by the Replacement Sheet for FIG. 2 submitted concurrently herewith, to depict the claimed “load” feature, as indicated by the Examiner. Applicants, therefore, respectfully request the withdrawal of the objection to the Drawings, under 37 CFR §1.83(a).

Applicants respectfully traverse the rejections of claims 1-3, 5, 7, 15-17, and 19, under 35 U.S.C. §102(b), for the reasons presented below:

I. Prior Art Rejections Under 35 U.S.C. §102(b)

Independent claim 1, sets forth a magnetic actuator for adjusting a force on a load, comprising:

*a first actuating part including a **first magnetic element and a second magnetic element** . . .*

*a second actuating part including a third magnetic element . . .*

*a displacing element attached to said first and second magnetic elements, said displacing element configured to displace said first and second magnetic elements relative to each other . . .*

wherein said first actuating part and said second actuating part are constructed and arranged to generate a magnetic force between said both actuating parts in a first direction with a load being attached to one of said first and second actuating parts.

As indicated above, claim 1, as amended positively recites the use of a displacing element that attaches to the first and second magnetic elements to displace the first and second magnetic elements relative to each other. These features are amply supported by the embodiments disclosed in the Specification. For example, in one of the disclosed embodiments, the Specification provides that the piezoelectric element PE is arranged between both magnets M1, M2 in such a way, that the first and second magnets M1, M2 can be displaced relative to each other, in a direction parallel to the central axis A1. (See, e.g., Specification, para. [0062], [0073]; FIG. 1).

There is nothing in the Hol '296 reference that teaches or suggests the combination of features recited in claim 1. In particular, the Hol '296 reference discloses an actuator comprising a first magnet sub-assembly 1; a second magnet sub-assembly 11, and a coil 21 interposed between the two assemblies 1, 11. (See Hol '296: col. 7, lines 31-34; FIG. 2A). The first magnet sub-assembly 1 is composed of a first main magnet 2, that is interposed between a second subsidiary magnet 4 and a third subsidiary magnet 3, and a second main magnet 7, that is interposed between a second subsidiary magnet 4 and a first subsidiary magnet 5. (See Hol '296: col. 7, lines 53-56; FIG. 2A).

The Hol '296 reference similarly discloses that the second magnet sub-assembly 11 is composed of a first main magnet 12, that is interposed between a second subsidiary magnet 14 and a third subsidiary magnet 15, and a second main magnet 17, that is interposed between a second subsidiary magnet 14 and a first subsidiary magnet 13. (*See Hol '296: col. 7, lines 57-60; FIG. 2A*). Based on this configuration, the Examiner alleged that the second subsidiary magnet 4 corresponds to the claimed displacement element and that the first main magnet 2 and the second main magnet 7 correspond to the claimed first and second magnetic elements.

Unlike the present invention, however, there is nothing in the Hol '296 reference that suggests that the first main magnet 2 and the second main magnet 7 move relative to each other, as required by claim 1. Nor is there anything in the reference that suggests that the second subsidiary magnet 4 functions to displace the first main magnet 2 and the second main magnet 7 relative to each other, as required by claim 1.

Moreover, the Hol '296 reference discloses that the first magnet sub-assembly 1 and the second magnet assembly 11 are precisely arranged so that the respective main and subsidiary magnets of the two assemblies 1, 11 face each other with magnetic polarization orientations that generate a uniform magnetic field between the pairs of main magnets 2, 12 and 7, 17. (*See Hol '296: col. 8, lines 9-12, 48-50, & 59-62; FIG. 2A*). Clearly, the precise arrangement between the first magnet sub-assembly 1 and the second magnet assembly 11 required to generate a uniform magnetic field between the pairs of main magnets 2, 12 and 7, 17 teaches away from the use of a displacing element that displaces the first and second magnetic elements relative to each other, as required by claim 1.

Further, the Hol '296 reference goes on to state that each of the magnet sub-assemblies has a back iron 6, 16, that adjoins each of the main magnets 2, 12 and 7, 17 and subsidiary magnets 3, 4, 5, and 13, 14, 15 in the sub-assemblies 1, 11 and preferably entirely covers the surfaces of all the magnets. (*See Hol '296: col. 8, lines 48-50, lines 13-19; FIG. 2A*). Thus, by adjoining the main 2, 12 and 7, 17 and subsidiary magnets 3, 4, 5, and 13, 14, 15 under a back iron cover, there is no way that

the first main magnet 2 and the second main magnet 7 are capable of being displaced relative to each other, as required by claim 1.

For at least the reasons discussed above, Applicants submit that claim 1 cannot be construed as being anticipated by the Hol '296 reference. Moreover, as best understood, none of the remaining references of record, whether taken alone or in any reasonable combination, teach the combination of features recited by claim 1. Accordingly, claim 1 is patentably distinguishable over all the references of record and the reconsideration and withdrawal of the prior art rejection, under 35 U.S.C. §102(b), is respectfully requested.

Applicants also submit that, because claims 2-7 depend either directly or indirectly from claim 1, claims 2-7 are patentable for at least the reasons presented with respect to claim 1 in addition to their additional limitations.

In addition, because independent claim 15 positively recites features similar to claim 1, claim 15 is patentable for at least the reasons presented with respect to claim 1. And, because claims 16-20 depend from claim 15, claims 16-20 are patentable for at least the reasons presented with respect to claims 1 and 15, as well as for their additional limitations.

## **II. Conclusion**

All matters having been addressed and in view of the foregoing, Applicants respectfully request the entry of this Amendment, the Examiner's reconsideration of this application, and the immediate allowance of pending claims 1-7 and 15-20.

Applicants' Counsel remains ready to assist the Examiner in any way to facilitate and expedite the prosecution of this matter.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,  
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**IN THE DRAWINGS**

Please substitute FIG. 2 of the originally-filed application with the attached Replacement Sheet that includes revised FIG. 2.